

## **REMARKS**

Claims 1, 8-14, 16, 17, 19, 20, 22, 23, 25 and 32-39 are rejected. Claims 1, 9, 10, 13, 14, 17, 19 and 25 have been amended. Claims 8, 16 and 36 have been cancelled. Claims 1, 9-14, 17, 20, 22, 23, 25, 32-35 and 37-39 are presently pending in the application. Favorable reconsideration of the application in view of the following remarks is respectfully requested.

Amended claim 1 corresponds to claim 16 written in independent form. Amended claim 25 corresponds to claim 36 written in independent form. These amendments do not create any new matter or new question issues, because they are merely an incorporation of dependant claims into independent claims.

### **Rejection of Claim under 35 U.S.C. § 112:**

In paragraph 1 of the Office Action the Examiner has rejected claim 19 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Claim 19 depends from cancelled claim 18. Applicants greatly thank the Examiner for pointing out this dependency error. Applicants have amended claim 19 as to comply with 35 U.S.C. § 112, second paragraph. Claim 19 now depends on independent claim 1. The basis for this amendment can be found on page 10 lines 19-24 of the specification as originally filed. Therefore, it is respectfully requested that this rejection be reconsidered and withdrawn.

### **Rejection of Claims under 35 U.S.C. § 103(a):**

In paragraph 4 of the Office Action the Examiner has rejected claims 1, 8-14, 16, 17, 19 and 25 under 35 U.S.C. § 103(a) as being unpatentable over the '119 Japanese patent in view of Imaeda. The Examiner indicates that the '119 Japanese patent discloses a label with an overcoat layer containing beads which impart a tactile feature to the label. The Examiner states that the '119 Japanese patent does not state that the adhesive is pressure sensitive. The

Examiner further indicates that Imaeda shows pressure sensitive adhesion to be old in the tactile feature printing art. The Examiner states that it would have been obvious to one of ordinary skill in the art at the time of the invention from the teaching of Imaeda to modify the label of the '119 Japanese patent to arrive at the present invention. The Examiner further states that forming a pattern in the textured surface is considered a matter of obvious design choice. This rejection is respectfully traversed.

When applying 35 U.S.C. § 103, the invention must be considered as a whole, the references must be considered as a whole and must suggest the desirability of making the combination, the references must be viewed without the benefit of impermissible hindsight, and the combination of the references must give a reasonable expectation of success. The references cited by the Examiner comprise non-analogous art. In order to rely on a reference as a basis for rejection of Applicants' invention, a reference must either be in the field of the Applicants' endeavor or reasonably pertain to the particular problem with which the invention is concerned. Here, the cited references are not in Applicants' field of endeavor, that is, the '119 Japanese patent discloses the use of an in-line molded label containing a hot melt adhesive and an overcoat layer containing inorganic beads to create roughness as to feed one label at a time. Imaeda discloses the formation of Braille pattern by the use of thermal expansion by using a thermal transfer ribbon and a thermal transfer unit. Imaeda discloses forming the Braille pattern while leaving the printed characters flat so that those unable to read Braille can decipher the orientation of a label. Imaeda transfers the printed characters by a physical transfer in a typewriter style apparatus, whereas the present invention utilizes a coating method to create images and textures. The problems solved by the '119 Japanese patent and Imaeda greatly differ and do not suggest combination. Since the cited references serve a different purpose and function, the Applicants respectfully suggest that the cited references are non-analogous art, and do not support a rejection based on obviousness. Furthermore, even when these references are combined there is not a reasonable expectation of success to arrive at the present invention. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the Applicants' disclosure. *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998). The present invention as amended discloses a label comprising an image

having at least one overcoat layer forming a textured surface in a pattern. Forming raised Braille letters after transfer and heating as disclosed in Imaeda combined with an overcoat layer with beads so that labels can be fed one at a time in an in-line mold process as disclosed in the '119 Japanese patent does not teach or suggest forming a textured surface in a pattern upon an image as in the present invention. Neither cited reference, alone or in combination, teaches, suggests or discloses forming a textured surface in a pattern on an image. Therefore, it is respectfully requested that this rejection be reconsidered and withdrawn.

In paragraph 5 of the Office Action the Examiner has rejected claims 25, 32 and 33 under 35 U.S.C. § 103(a) as being unpatentable over Bohan et al. in view of Imaeda. The Examiner indicates that Bohan et al. discloses an image with an overcoat, which can contain particles that impart surface roughness to the overcoat. The Examiner states that Bohan et al. does not state the use of adhesive that is pressure sensitive. The Examiner states that Imaeda shows this feature to be old in the tactile feature printing art. The Examiner further indicates that it would have been obvious to one of ordinary skill in the art at the time of the invention from the teaching of Imaeda to modify the label of Bohan et al. This rejection is respectfully traversed.

As discussed above Imaeda is non-analogous art and does not suggest combination with Bohan et al. There is no disclosure within the references that suggests combination. Imaeda is classified in Class 430 whereas Bohan et al is classified in Class 428. Since the cited references are contained in different classifications and serve a different purpose the Applicants respectfully suggest that the cited references are non-analogous art, and do not support a rejection based on obviousness. Furthermore, even when these references are combined there is not a reasonable expectation of success to arrive at the present invention. Bohan et al. discloses a clear protective coat that is provided to a portion of the surface of a photographic image utilizing polymer toner particles. Pressure sensitive adhesives, as disclosed in Imaeda, are not suitable for toner fused photographic materials, as disclosed in Bohan et al. A rejection based on obviousness is unwarranted because these references combined do not provide a reasonable expectation of success of arriving at the present invention. Therefore, it is respectfully requested that this rejection be reconsidered and withdrawn.

In paragraph 6 of the Office Action the Examiner has rejected claims 1, 8, 10-13, 21, 22, 31, 34 and 37-39 under 35 U.S.C. § 103(a) as being unpatentable over Bohan et al. in view of Imaeda. The Examiner indicates that Bohan et al. discloses the basic inventive concept of the present invention, an image formed using silver halide with an overcoat that imparts tactile features to the image. The Examiner states that Bohan et al. does not disclose the use as a pressure sensitive adhesive label. The Examiner indicates that Imaeda shows this feature to be old in the tactile feature printing art. The Examiner states that it would have been obvious to one of ordinary skill in the art at the time of the invention from the teaching of Imaeda to modify the tactile image of Bohan et al. This rejection is respectfully traversed.

As discussed above Imaeda is non-analogous art and does not suggest combination with Bohan et al. There is no disclosure within the references that suggests combination. Since the cited references are contained in different classifications and serve a different purpose the Applicants respectfully suggest that the cited references are non-analogous art, and do not support a rejection based on obviousness. Furthermore, as discussed above, combination of these references does not provide a reasonable expectation of success of arriving at the present invention, and thus does not warrant a rejection based on obviousness. Therefore, it is respectfully requested that this rejection be reconsidered and withdrawn.

In paragraph 7 of the Office Action the Examiner has rejected claims 35 and 36 under 35 U.S.C. § 103(a) as being unpatentable over Bohan in view of Imaeda as applied to claims 25, 32 and 33 and further in view of Sokyrka. The Examiner indicates that Bohan et al., as modified, discloses the present invention's basic inventive concept with the exception of forming the layer using a primer and a UV cured outer layer and forming the overcoat layer as discontinuous. The Examiner further indicates that Sokyrka shows these features to be old in the printing art. The Examiner states that it would have been obvious to one of ordinary skill in the art at the time of the invention from the teaching of Sokyrka to modify the label of Bohan et al by forming the overcoat using a primer and a UV cured compound to produce tactile features quickly and to provide a discontinuous outer layer to provide extended tactile features which can be felt more easily. This rejection is respectfully traversed.

As discussed above Imaeda is non-analogous art and does not suggest combination with Bohan et al or Sokyrka. There is no disclosure within the references that suggests combination. Since the cited references are contained in different classifications and serve a different purpose the Applicants respectfully suggest that the cited references are non-analogous art, and do not support a rejection based on obviousness. Furthermore, claim 35 benefits from dependency on claim 25, which as discussed above is non-obvious. Therefore, it is respectfully requested that this rejection be reconsidered and withdrawn.

In paragraph 8 of the Office Action the Examiner has rejected claim 23 under 35 U.S.C. § 103(a) as being unpatentable over the '119 Japanese patent in view of Imaeda as applied to claims 1, 8-14, 16, 17, 19 and 25 and further in view of Yamada. The Examiner indicates that the '119 Japanese patent, as modified, discloses the present invention's basic inventive concept with the exception of forming the outer layer from gelatin. The Examiner further indicates that Yamada shows this feature to be old in the printing art. The Examiner states that it would have been obvious to one of ordinary skill in the art at the time of the invention from the teaching of Yamada to modify the label of the '119 Japanese patent by forming the outer layer from a gelatin to protect the label. This rejection is respectfully traversed.

As discussed above Imaeda is non-analogous art and should not be combined with the other references. There is nothing within the references that suggests combination. Furthermore, even when these references are combined there is not a reasonable expectation of success to arrive at the present invention. Yamada discloses gelatin outer layer but does not mention a textured surface in a pattern. The present invention as amended discloses a label comprising an image having at least one overcoat layer forming a textured surface in a pattern. The references do not teach, suggest or disclose forming a textured surface in a pattern on an image. Furthermore, claim 23 benefits from dependency on claim 1, which as discussed above is non-obvious. Therefore, it is respectfully requested that this rejection be reconsidered and withdrawn.

For the reasons above it is respectfully requested that the above amendment be entered and that this application receive an early Notice of Allowance. In the alternative, it is respectfully requested that the amendments above be entered in order to place the application in better condition for appeal.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Paul A. Leipold", written over a horizontal line.

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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.